

REMARKS

At the outset, Applicant would like to thank the Examiner for the detailed Office Action and the indication that claims 5-15, 17-23, 25, and 26 contain allowable subject matter.

Favorable reconsideration, reexamination, and allowance of the present patent application are respectfully requested in view of the foregoing amendments and the following remarks.

Summary of Office Action

Claims 1, 4, 16, and 24 stand rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Patent Application No. 2002 -289926 to Tatsuya Motoike (Motoike'926). Claims 2 and 3 stand rejected as obvious over Motoike'926 in view of U.S. Patent No. 6,850,001 to Takekuma (Takekuma'001).

Summary of Response to Office Action

By this Amendment, claims 1, 7, 8, and 23 are amended. Claims 1-26 are pending in this application, with claims 1, 7, and 8 being the only independent claims.

The Claims Define Allowable Subject Matter

In the Office Action, beginning at page 2, claims 1, 4, 16, and 24 were rejected under 35 U.S.C. § 102(b) as anticipated by the Motoike'926 patent application. This rejection is respectfully traversed, and Applicant requests reconsideration for at least the following reasons.

The Motoike'926 patent application fails to disclose or teach at least the feature of an optical member disposed above the base and apart from the LED chip and having an inner surface facing towards the LED chip, and a light shielding portion disposed on the inner surface of the optical member and configured to form a cutoff suited for a light distribution pattern, as recited in independent claim 1.

By contrast, Motoike'926 discloses a white light device that includes a phosphor 6 located above a blue LED chip 17. As shown in Fig. 6 of Motoike'926 (reproduced below), a fluorescent substance 6 is located above the blue LED 17 and is attached to the bottom of a lens body 4. A light shielding frame 5 includes a base 26 that secures the lens section 20 next to the LED 17.

It appears from the outstanding Office Action that the Examiner considers the light shielding frame 5 to be the "light shielding portion" as recited in pending claim 1. It also appears that any surface of the lens body 4 located at or below the light shielding frame 5 is being considered by the Examiner to be an "inner surface." Applicant respectfully disagrees with this interpretation of Motoike'926. Moreover, Motoike'926 does not disclose or teach an optical member...having an inner surface facing towards the LED chip, and a light shielding portion disposed on the inner surface of the optical member and configured to form a cutoff suited for a light distribution pattern, as recited in independent claim 1.

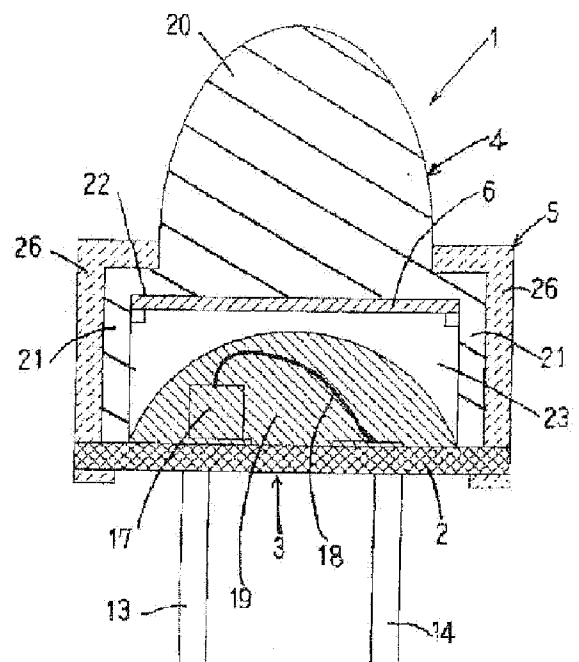


Fig. 6 of Motoike'926

In the Office Action, paragraph [0044] and claim 2 of Motoike'926 are referenced to provide support for the position that the light shielding member 5 is disposed on the inner surface of the optical member. However, it is respectfully submitted that claim 2 of Motoike'926 does not refer to a light shielding member 5. In addition, paragraph [0044] of Motoike'926 does not describe the light shielding frame 5 as forming a cutoff, or located on an inner surface facing towards the LED chip. Rather, paragraph [0050] of Motoike'926 describes the structural/functional characteristics of the light shielding frame 5. For example, according to the Applicant's translation of paragraph [0050] of Motoike'926, the light shielding frame of Motoike'926 is located to surround the pedestal section, and as a result, blue light emitted from the sides of the blue LED is shielded by the light shielding frame. Thus,

it is respectfully submitted that the Examiner's interpretation and argument regarding the light shielding frame of Motoike'926 are incorrect, and that claim 1 includes features that are simply not disclosed or taught by the Motoike'926 reference. It is respectfully submitted that neither the drawings nor the specification of Motoike'926 disclose or teach at least the feature of an optical member disposed above the base and apart from the LED chip and having an inner surface facing towards the LED chip, and a light shielding portion disposed on the inner surface of the optical member and configured to form a cutoff suited for a light distribution pattern, as recited in independent claim 1.

It is a common patent law principle that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (citing *Verdegaal Bros. v. Union Oil Co. Of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

In this case, Motoike'926 fails to disclose at least the above-referenced features of Applicant's claim 1. Accordingly, Motoike'926 cannot be considered to anticipate independent claim 1.

Further, since claims 4, 16, and 24 depend from and respectively incorporate all the features of claim 1, claims 4, 16, and 24 are also not anticipated by Motoike'926 at least for the above reasons for which independent claim 1 is not anticipated. Thus, Applicant respectfully requests that the rejection of claims 1, 4, 16, and 24 under 35 U.S.C. § 102(b) be withdrawn.

In the Office Action, beginning at page 4, claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as obvious over the disclosure of Motoike'926 in view of Takekuma'001. This rejection is respectfully traversed, and Applicant requests reconsideration for at least the following reasons.

At the outset, Applicant respectfully submits that Takekuma'001 fails to disclose or teach, either explicitly or implicitly, all of the features of claim 1, from which claims 2 and 3 depend, as described above. Specifically, Takekuma'001 fails to disclose or teach at least the feature of an optical member disposed above the base and apart from the LED chip and having an inner surface facing towards the LED chip, and a light shielding portion disposed on the inner

surface of the optical member and configured to form a cutoff suited for a light distribution pattern, as recited in Applicant's claim 1.

Because both Motoike'926 and Takekuma'001, either alone or in combination, fail to disclose or teach the above-referenced features, as well as other features, of Applicant's claims 2 and 3, it is respectfully submitted that there is no *prima facie* case for obviousness.

The Office bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. § 2142. If the Office fails to set forth a *prima facie* case of obviousness, Applicant is under "no obligation to submit evidence of nonobviousness," such as unexpected results or commercial success. *Id.* In other words, if the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness as to a given claim, then that claim is not obvious without any specific evidence of nonobviousness by Applicant.

In order to establish a *prima facie* case of obviousness, the Office must satisfy three requirements. M.P.E.P. § 2142. First, "the prior art reference, or references when combined, must teach or suggest *all* the claim limitations." *Id.* (emphasis added). Second, the Office must show that there is "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." *Id.* Finally, "there must be a reasonable expectation of success." *Id.*

In the present case, as stated above, the cited references fail to teach or suggest at least the feature of an optical member disposed above the base and apart from the LED chip and having an inner surface facing towards the LED chip, a light shielding portion disposed on the inner surface of the optical member and configured to form a cutoff suited for a light distribution pattern, as recited in Applicant's claim 1. Thus, the Office Action fails to establish a *prima facie* case of obviousness as to claims 2 and 3, both of which depend from and include the features of independent claim 1.

Further, the Office Action attempts to provide motivation for modifying Motoike'926 by stating that it would have been obvious for one of ordinary skill in the art to provide the light source of Motoike'926 with a ceramic base "for the purpose and advantage of providing a more

cost effective manufacturing process of the light source device.” It is respectfully submitted that including a ceramic base would not have created a more cost effective process for manufacture. The design requirements, machining, and material costs for using ceramic materials are relatively high as compared to other materials from which the lamp parts can be made. Therefore it is respectfully submitted that the motivation for combining the references as stated in the Office Action is deficient.

For at least the above reasons, it is respectfully submitted that the Office Action fails to meet the requirements for establishing a *prima facie* case of obviousness. Therefore, Applicant requests that the rejection of claims 2 and 3 under 35 U.S.C. § 103(a) be withdrawn.

Conclusion

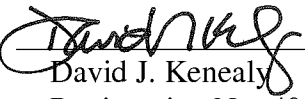
Applicant respectfully submits that the present patent application is in condition for allowance. An early indication of the allowability of this patent application is therefore respectfully solicited.

If the Patent Examiner believes that a telephone conference with the undersigned would expedite passage of this patent application to issue, she is invited to call on the number listed below.

PATENT APPLICATION NO.: 10/808,551
Attorney Docket No.: ST3001-0039
Amendment and Response
Page 12 of 12

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. If, however, additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and the Commissioner is hereby authorized to charge fees necessitated by this paper, and to credit all refunds and overpayments, to Applicant's representative's Deposit Account listed on the original patent application Transmittal document.

Respectfully submitted,
Cermak & Kenealy LLP

By:  /djk/
David J. Kenealy
Registration No. 40,411

U.S.P.T.O. Customer Number 39083
Cermak & Kenealy LLP
515 E. Braddock Rd., Suite B
Alexandria, Virginia 22314

703.778.6610 (v)
703.652.5101 (f)

Date: January 29, 2007